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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/017,973	12/07/2001	Mitsuaki Oshima	MTS-520US5	9590

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EXAMINER

CALLAHAN, PAUL E

ART UNIT

PAPER NUMBER

2134

DATE MAILED: 12/03/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	10/017,973	OSHIMA ET AL.	
	Examiner Paul E. Callahan	Art Unit 2134	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 07 December 2001.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 36-41 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 36-41 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:

- Certified copies of the priority documents have been received.
- Certified copies of the priority documents have been received in Application No. 08/560,015.
- Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.

4) Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_

5) Notice of Informal Patent Application (PTO-152)

6) Other: \_\_\_\_\_

**DETAILED ACTION**

***Response to Amendment***

1. Claims 1-27 have been cancelled by the first preliminary amendment received 12/07/2001. The first preliminary amendment states that new claims 28-35 are to be added yet only new claims 28-30 are found with the amendment. The second preliminary amendment received 6/21/02 cancels claims 28-35 and adds new claims 36-41. The applicant is required to either resubmit a new, corrected copy of the first preliminary amendment which includes the missing claims 31-35, or renumber the claims submitted as new with the second preliminary amendment as new claims 31-35. The new claims sent with the second preliminary amendment received 6/21/02 and numbered therein as new claims 36-41 have been examined.

***Reissue Applications***

2. The Amendment filed 8/30/2002 is objected to as not being of proper form. The amendment should be drawn relative to the claims in the Patent in a reissue case and not the proposed reissue application claim. Therefore, as per 37 CFR 1.173, proper underlining of all of the text of any new claim should be shown. See MPEP 1453. The amendment filed 8/30/2002 proposes amendments to the claims that do not comply with 37 CFR 1.173(b), which sets forth the manner of making amendments in reissue applications. A supplemental paper correctly amending the reissue application is required.

3. Applicant is reminded of the continuing obligation under 37 CFR 1.178(b), to timely apprise the Office of any prior or concurrent proceeding in which Patent No. 5,761,301 is or was

involved. These proceedings would include interferences, reissues, reexaminations, and litigation.

Applicant is further reminded of the continuing obligation under 37 CFR 1.56, to timely apprise the Office of any information which is material to patentability of the claims under consideration in this reissue application.

These obligations rest with each individual associated with the filing and prosecution of this application for reissue. See also MPEP §§ 1404, 1442.01 and 1442.04.

***Reissue Oath / Declaration***

4. The reissue oath/declaration filed with this application is defective (see 37 CFR 1.175 and MPEP § 1414) because of the following:

- The Reissue Declaration states that the error being corrected is that the inventors did not claim “the reflective layer being trimmed by a laser to form a bar code like trimming pattern.” The pending claims however, do not correct the error and the Oath/ Declaration is objected to as a result. See MPEP 1414II).
- The error stated in the reissue Oath/ Declaration is the same as that stated in the Parent Reissue application. The error will have been corrected in the parent application and therefore the Declaration is objected to on the basis that the error stated no longer exists. See MPEP 1414(II).

5. Claims 36-41 are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.

The nature of the defect(s) in the declaration is set forth in the discussion above in this Office action.

6. The original patent, or a statement as to loss or inaccessibility of the original patent, must be received before this reissue application can be allowed. See 37 CFR 1.178.

### ***Double Patenting***

7. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefore ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

8. Claims 36-41 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-12, 36 and 37 of co pending Application No. 09/588, 364. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

### ***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 36-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kato, US patent 4,503,531, in view of Ikeda, US Patent 5,050,150.

Kato teaches a first substrate, an information recording layer formed on said substrate and a second substrate, wherein the information recording layer is formed between the first and the second substrate with a second information layer formed on the second substrate in fig.s 1 and 2. Kato does not teach a barcode pattern being formed on the information-recording layer readable by a pick-up for reading data. However Ikeda does teach such a bar code formed on an information-recording layer in fig.s 1 and 2, and in col. 2 lines 39-41. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate this feature of Ikeda into the system of Kato. It would have been advantageous to do so as this would allow for greater ability to enforce a copyright on digital media recorded on an optical disk by allowing for use information to be stored in an unalterable barcode.

### ***Conclusion***

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul E. Callahan whose telephone number is (703) 305-1336. The examiner can normally be reached on M-F from 9 to 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron, can be reached on (703) 305-1830. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-7239 Official Faxes, (703) 746-7240 Unofficial Faxes, and (703) 746-7238 After Final Faxes.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

11/26/02

Powl Callahan

*Gilberto B*

**GILBERTO BARRON**  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100